

REMARKS

I. Status of Claims

Applicants have amended claims 1, 3, 8-10, and 14 as set forth above to more appropriately define the invention. In particular, claims 1, 3, 8-10, and 14 are amended to recite, in part, "porous silica particles" instead of "silicon based porous particles." Support for the amendment to claims 1, 3, 8-10, and 14 may be found in Applicants' specification at, for example, page 8, lines 5-8, and page 10, line 9, Table 1 where Example 1 is described. The amendments to claims 1, 3, 8-10, and 14, therefore, do not introduce any new matter. Claims 1-10 and 12-14 remain pending and under current examination.

II. Rejections under 35 U.S.C. § 103

A. Claims 1-5, 7-10, and 12-14

The Examiner rejected claims 1-5, and 7-10, and 12-14¹ under 35 U.S.C. § 103(a) as being unpatentable over EP 268 938 to Kadokura et al. ("Kadokura") in view of Hall et al., U.S. Pat. App. Pub. No. 2002/0009564 ("Hall") and U.S. Patent No. 7,101,536 to Mongiat et al. ("Mongiat"). Applicants respectfully traverse the rejection for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In its decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation ("TSM") test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a "rigid and mandatory" formula, the test can provide "helpful insight" to an obviousness inquiry. *Id.*

The Examiner alleged that Kadokura "teach[es] cosmetic compositions ... comprising a lamina comprising a matrix substance (e.g. silicon dioxide) and a finely divided metal or metal compound dispersed therein." Office Action at 2.

Without acceding to the Examiner's characterization of Kadokura, Applicants submit that Kadokura does not disclose or suggest Applicants' claimed invention as recited in amended independent claim 1. For example, Kadokura does not disclose "porous silica particles having an aspect ratio of at least 2, and ... an optically active substance incorporated into said porous particles," as recited in claim 1. Instead, Kadokura discloses a laminar substance used as a matrix, and discloses silicon as an example of a laminar substance. Kadokura, page 2, line 55, through page 3, line 3. The lamina may have finely divided silica dispersed in the laminar substance. Id., page 3, lines 22-23 and 43-46. But neither that silicon laminar substance or that

finely divided silica can be equated to the porous silica particles having an optically active substance incorporated therein, as recited in claim 1. This is at least because Kadokura does not disclose or suggest that its laminar substance should be porous.

The Examiner apparently acknowledges this deficiency of Kadokura, and therefore relies on Hall for its alleged disclosure that "silicone particles calcined at about 300 C to about 400 C, produce porous particles." Id. at 3. Without acceding to this allegation, Applicants submit that one of ordinary skill in the art at the time of the present invention would not have considered combining Hall with Kadokura.

Hall is directed to reducing friction between PET preforms and bottles, and discloses "[a]n additive system for polyester polymers" intended to achieve this objective. Hall, Abstract and paragraph [0001]. Specifically, Hall discloses adding poly(methylsilsequioxane) to PET to "reduce surface friction without producing objectionable levels of haze" in the PET. Id., paragraph [0016]. The compound poly(methylsilsequioxane) is an example of a silicone, and Hall discloses the structure of silicones for use in Hall's invention in, for example, paragraphs [0018] - [0022].

One of ordinary skill in the art at the time of the present invention would have appreciated that silicones are not the same as silica, and would not have considered substituting silicones into the lamina disclosed by Kadokura. Indeed, Kadokura does not disclose or suggest the use of silicones in its lamina. Further, one of ordinary skill in the art would not have considered that any disclosure by Hall regarding the porosity of silicones, with which Applicants do not necessarily agree, could be applicable to silica. Moreover, Hall discloses adding silicones to reduce surface friction for

preforms and bottles, an application that is unrelated to Kadokura's UV screening laminar substance.

For at least these reasons, one of ordinary skill in the art at the time of the present invention would not have considered combining the teachings of Kadokura with the teachings of Hall.

However, even if one of ordinary skill in the art had combined Kadokura and Hall, Hall does not overcome the deficiencies of Kadokura. This is at least because Hall does not disclose or suggest "porous silica particles having an aspect ratio of at least 2, and ... an optically active substance incorporated into said porous particles," as recited in amended independent claim 1.

Mongiat also does not overcome the deficiencies of Kadokura. The Examiner admitted that Kadokura "does not teach the spherical powder of Claims 11 and 12," and relied on Mongiat for its purported disclosure regarding spherical powders. Office Action at 3. Mongiat discloses UV-protection formulations (Mongiat, Abstract) but without acceding to the Examiner's characterization, Applicants submit that Mongiat does not disclose or suggest "porous silica particles having an aspect ratio of at least 2, and ... an optically active substance incorporated into said porous particles," as recited in amended independent claim 1.

For at least these reasons, amended independent claim 1 should be allowable over Kadokura, Hall, and Mongiat. Amended independent claim 14 differs in scope from claim 1 but recites similar limitations and should also be allowable at least for reasons similar to those presented regarding claim 1. In addition, claims 2-5, 7-10, 12, and 13, which depend from claim 1, should be allowable. Applicants, therefore,

respectfully request reconsideration and withdrawal of the rejection of claims 1-5, 7-10, and 12-14.

B. Claim 6

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Kadokura and Mongiat, further in view of Reinehr et al., WO 01/43714 ("Reinehr"). Applicants respectfully traverse the rejection for at least the followings reasons.

As explained above, amended independent claim 1 should be allowable over Kadokura and Mongiat. Reinehr does not overcome the deficiencies of Kadokura. The Examiner relied on Reinehr for its alleged disclosure of the use of fluorescent substances in UV protecting skin care compositions. Office Action at 4. Without acceding to this characterization of Reinehr, Applicants submit that Reinehr does not disclose or suggest "porous silica particles having an aspect ratio of at least 2, and ... an optically active substance incorporated into said porous particles," as recited in amended independent claim 1.

Amended independent claim 1, and claim 6 which depends from claim 1, should be allowable over Kadokura, Mongiat, and Reinehr. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection of claim 6.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of the present application, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 13, 2009

By: /Brandon B. Crisp/
Brandon B. Crisp
Reg. No. 63,138
(571) 203-2768